

ESTTA Tracking number: **ESTTA714605**

Filing date: **12/15/2015**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

| | |
|---------------------------|--|
| Proceeding | 91224830 |
| Party | Defendant USAmeriBank |
| Correspondence Address | J. TODD TIMMERMAN SHUMAKER, LOOP & KENDRICK, LLP 101 E KENNEDY BLVD STE 2800 TAMPA, FL 33602-5153 ttimmerman@slk-law.com |
| Submission | Answer |
| Filer's Name | J. Todd Timmerman |
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| Signature | /J. Todd Timmerman/ |
| Date | 12/15/2015 |
| Attachments | skm_c554e15121509580_00000000_00000001.PDF(185747 bytes) |

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|---------------------|---|------------------------------------|
| U.S. BANK N.A. |) | |
| |) | |
| |) | Opposition No.: 91224830 |
| Opposer, |) | |
| |) | |
| v. |) | Application No.: 86/537,865 |
| |) | |
| USAMERIBANK, |) | Trademark: USAMERIBANK |
| |) | (and design) |
| Applicant. |) | |
| |) | |

Applicant, USAMerriBank (“Applicant”), by and through its undersigned attorneys and pursuant to Rule 2.106 of the Rules of Practice in Trademark Cases, files this its Answer and Affirmative Defenses to the Notice of Opposition filed by Opposer, U.S. Bank N.A. (“Opposer”), and states as follows:

1. Applicant is without knowledge or information sufficient to form a belief as to the truth of, and therefore denies, the allegations contained in Paragraph 1 of the Notice of Opposition.

2. Applicant is without knowledge or information sufficient to form a belief as to the truth of, and therefore denies, the allegations contained in Paragraph 2 of the Notice of Opposition.

3. In response to Paragraph 3 of the Notice of Opposition, Applicant admits that copies of registration certificates and TSDR reports are attached to the Notice of Opposition as Exhibit A, but refers the Board to such documents for a full recitation of their terms. Applicant

is without knowledge or information sufficient to form a belief as to the truth of, and therefore denies, the remaining allegations contained in Paragraph 3 of the Notice of Opposition.

4. Applicant is without knowledge or information sufficient to form a belief as to the truth of, and therefore denies, the allegations contained in Paragraph 4 of the Notice of Opposition.

5. Applicant is without knowledge or information sufficient to form a belief as to the truth of, and therefore denies, the allegations contained in Paragraph 5 of the Notice of Opposition.

6. Applicant admits the allegations contained in Paragraph 6 of the Notice of Opposition.

7. Applicant admits the allegations contained in Paragraph 7 of the Notice of Opposition.

8. Applicant denies the allegations contained in Paragraph 8 of the Notice of Opposition.

COUNT I
LIKELIHOOD OF CONFUSION AND PRIORITY

9. In response to Paragraph 9 of the Notice of Opposition, Applicant restates its responses to Paragraphs 1 through 8 of the Notice of Opposition as if fully restated herein.

10. Applicant is without knowledge or information sufficient to form a belief as to the truth of, and therefore denies, the allegations contained in Paragraph 10 of the Notice of Opposition.

11. Applicant denies the allegations contained in Paragraph 11 of the Notice of Opposition.

12. Applicant denies the allegations contained in Paragraph 12 of the Notice of Opposition.

13. Applicant denies the allegations contained in Paragraph 13 of the Notice of Opposition.

14. Applicant denies the allegations contained in Paragraph 14 of the Notice of Opposition.

COUNT II
FALSE ASSOCIATION

15. In response to Paragraph 15 of the Notice of Opposition, Applicant restates its responses to Paragraphs 1 through 14 of the Notice of Opposition as if fully restated herein.

16. Applicant denies the allegations contained in Paragraph 16 of the Notice of Opposition.

17. Applicant is without knowledge or information sufficient to form a belief as to the truth of, and therefore denies, the allegations contained in Paragraph 17 of the Notice of Opposition.

18. Applicant denies the allegations contained in Paragraph 18 of the Notice of Opposition.

19. Applicant denies the allegations contained in Paragraph 19 of the Notice of Opposition.

COUNT III
DILUTION

20. In response to Paragraph 20 of the Notice of Opposition, Applicant restates its responses to Paragraphs 1 through 19 of the Notice of Opposition as if fully restated herein.

21. Applicant is without knowledge or information sufficient to form a belief as to the truth of, and therefore denies, the allegations contained in Paragraph 21 of the Notice of Opposition.

22. Applicant is without knowledge or information sufficient to form a belief as to the truth of, and therefore denies, the allegations contained in Paragraph 22 of the Notice of Opposition.

23. Applicant denies the allegations contained in Paragraph 23 of the Notice of Opposition.

24. Applicant denies the allegations contained in Paragraph 24 of the Notice of Opposition.

FIRST AFFIRMATIVE DEFENSE

25. Opposer's Notice of Opposition fails to state a claim upon which relief may be granted.

SECOND AFFIRMATIVE DEFENSE

26. On October 12, 2006, Applicant applied to register the mark USAMERIBANK for:

Banking services; on-line banking services; checking account services; savings account services; automated teller machine services; credit card services; credit card processing services; debit card services; commercial and residential financing and lending services; home equity lending services; mortgage lending services; cash advance services; check cashing services; money order services; travelers' check services; bill payment services; mortgage brokerage services.

The application was assigned Serial No. 77/019,589.

27. The USAMERIBANK mark was registered on November 25, 2008 under Registration No. 3,537,548 (the "548 Registration").

28. The '548 Registration is valid and subsisting, and has not been canceled, revoked, or abandoned.

29. The '548 Registration has become incontestable under 15 U.S.C. § 1065.

THIRD AFFIRMATIVE DEFENSE

30. Opposer does not have the exclusive right to use the term BANK under any registration or applicable law.

FOURTH AFFIRMATIVE DEFENSE

31. Opposer does not have the exclusive right to use the colors red, white, and blue under any registration or applicable law.

FIFTH AFFIRMATIVE DEFENSE

32. On information and belief, Opposer's claims are barred by the doctrines of laches, waiver, estoppel, and/or acquiescence.

WHEREFORE, Applicant prays that this Opposition be dismissed, that its Application Serial No. 86/537,865 be granted, and that the mark therein be registered.



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Attorneys for Applicant, USAmeriBank

December 15, 2015

PROOF OF SERVICE

The undersigned hereby certifies that the foregoing Answer and Affirmative Defenses has been served upon Attorneys for Opposer, Kathryn K. Przywara, Esquire and Lynda E. Roesch, Esquire, Dinsmore & Shohl LLP, 1900 Chemed Center, 255 East Fifth Street, Cincinnati, Ohio 45202, as follows:

- _____ by delivering a copy of the paper to the person served;
- _____ by leaving a copy at the usual place of business of the person served, with someone in the person's employment;
- _____ by leaving a copy at the residence of the person served, with a member of the person's family over the age of fourteen years and of discretion, since the person is not believed to have a usual place of business;
- _____ by transmitting a copy to the person served by the "Express Mail Post Office to Addressee" service of the United States Postal Service;
- ☒ by transmitting a copy to the person served by first class mail;
- _____ by transmitting a copy by overnight courier;

on December 15, 2015.



J. Todd Timmerman, Esquire